

## **REMARKS/ARGUMENTS**

Claims 1-15 are pending in this application. Claim 1 has been amended to more clearly define the invention. The amendment is supported by the disclosure at p. 9, lines 1-4 of the specification and thus it adds no new matter to this case. In addition, claim 14 has been amended to correct a spelling error. The amendment is also supported by the application as originally filed and thus it too raises no issue of new matter. Upon entry of this Amendment, claims 1-15 will be pending in the application.

### **Formal Objections Regarding Priority Claim**

At page 2 of the Office Action, the Examiner acknowledges applicants' claim for priority in this case. The Examiner, however, suggests that the Cross-Reference to Related Applications on p. 1 of the specification be amended to update the status of the parent application and to slightly revise the wording contained in that section.

In response, applicants have amended the specification as suggested by the Examiner and these amendments, which add no new matter to the application, are believed to overcome the Examiner's objections. The Examiner is, thus, respectfully requested to reconsider and withdraw the objections to the specification.

### **Double Patenting Rejection**

Claims 1-15 of the present application are rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-15 of U.S. Patent No. 6,727,095 which issued based on the 'parent' to the present application. The bases for this ground of rejection are set forth on p. 3 of the Office Action. This rejection is respectfully traversed.

Nevertheless, in order to advance the progress of this application, submitted with this response is a Terminal Disclaimer executed by authorized representatives of the Assignee of this application together with the required fee of \$130.00 for submitting the Disclaimer. The Terminal Disclaimer is believed to overcome the double patenting rejection and the Examiner is, thus, respectfully requested to reconsider and withdraw the subject rejection.

### **Objection to the Claims**

Claim 14 is objected to due to a misspelling in the word “glutamine” in line 1. The claim has thus been amended to correct this typographical error. No new matter is added by this change. The Examiner is respectfully requested to reconsider and withdraw the objection to the claims based on the amendment to claim 14.

### **Claim Rejections Under 35 U.S.C. §112**

Claims 1-15 are rejected under 35 U.S.C. §112, first paragraph, due to an alleged failure on the part of those claims to comply with the ‘written description’ requirement of §112. The bases of the Examiner’s ground for rejection are set forth at pp. 4-6 of the Office Action. The rejection is respectfully traversed.

In response to the rejection, applicants have amended claim 1 of the application, which is the only independent claim in this case, to clarify that the hybridization described in subparagraph d) of the subject claim is that hybridization which occurs under less-stringent hybridization conditions, as described at page 9, lines 1-4 of applicants’ specification.

As amended, therefore, applicants believe that the subject matter as now recited in the claim is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the invention as now claimed. The Examiner is, therefore, respectfully requested to reconsider and withdraw the rejection of claims 1-15 under 25 U.S.C. 112, first paragraph.

### **Claim Rejections Under 35 U.S.C. §102**

Claims 1-6, 9, 10 and 12 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Temple et al., *Mol. Gen. Genet.*, 1993, Vol. 236, pp. 315-325 (“Temple”) for the reasons given on p. 7 of the Office Action. This rejection is respectfully traversed.

In response to the rejection, applicants submit that Temple does not relate to transformed sugar beet plants. Instead, it relates to tobacco plants. As such, the sequences taught for use in the present invention and, in particular, as now covered in independent claim 1 as amended, are not disclosed in the Temple reference. As a result, the Examiner is respectfully requested to reconsider and withdraw the §102 rejection of claim 1 based on the subject reference. Moreover,

as the other rejected claims, i.e., 2-6, 9, 10 and 12 all depend, directly or indirectly on claim 1, they each contain all of the recitations found in the independent claim. As such these dependent claims are believed to distinguish the invention over the cited art for the same reasons as claim 1 and thus, the rejection of the dependent claims should be withdrawn as well.

### **Claim Rejections Under 35 U.S.C. §103**

Claims 7, 8, 11 and 13-15 are rejected under 35 U.S.C. §103 over Temple taken in combination with Lindsay et al., *J. Exp. Bot.*, 1990, Vol. 41, pp. 529-536 (“Lindsay”), Stockhaus et al., *Proc. Natl. Acad. Sci.*, 1987, Vol. 84, pp. 7943-7947 (“Stockhaus”) and Smart et al., *Plant Cell*, 1991, Vol. 3, pp. 647-656 (“Smart”) for the reasons provided on pp. 8-9 of the Office Action. This rejection is respectfully traversed.

The basis upon which claims 1-6, 9, 10 and 12 distinguish over Temple are set forth above in the discussion relating to the rejection under §102 and that discussion is incorporated herein by reference.

As indicated above, whereas the present invention relates to transformed sugar beet plants, Temple is directed to tobacco plants. Further thereto, Lindsay only generally discusses processes for the preparation of transgenic sugar beets, whereas Stockhaus discloses a leaf specific ST-LS promoter and Smart discloses a heat-inducible promoter.

The sequences described in the prior art are different from those recited in applicants’ claims, in particular (independent) claim 1. Applicants thus submit that the prior art sequences provide no suggestion or motivation for using those sequences, as do applicants, for obtaining an advantageous transformation and expression in senescent leaves of a transgenic plant, in particular a sugar beet plant. That is, the sequences disclosed in the prior art do not provide any hint or suggestion that sequences not described therein, i.e, the sequences used with the present invention, may be used in the manner herein claimed. More particularly, there is no teaching or suggestion in the cited prior art that the sequences taught thereby can be used to prevent the expression of a protein having the activity of a glutamine synthetase in the senescent leaves of a transgenic plant.

For the reasons above, therefor, the Examiner is respectfully requested to reconsider and withdraw the rejection of applicants’ claims under §103.

### Summary

Applicants submit that the claim amendments and arguments set forth above are believed to be sufficient to overcome all of the grounds for objection and rejection of the claims of this application. If the Examiner does not agree and believes that an interview would serve to advance the prosecution of this case, he is respectfully invited to telephone applicants' representatives at the number below and such an interview will be arranged.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
THROUGH THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
EFS FILING SYSTEM  
ON JANUARY 26, 2007

Respectfully submitted,



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